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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/022,592	12/13/2001	Victor B. Lortz	884.501US1	6044

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EXAMINER

DAVIS, ZACHARY A

ART UNIT	PAPER NUMBER
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2137

DATE MAILED: 07/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/022,592

Applicant(s)

LORTZ, VICTOR B.

Examiner

Zachary A. Davis

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 December 2001.
2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-17 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 13 December 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 20020304.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Drawings

1. The drawings are objected to because they include hand-drawn elements and hand-written labels. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

2. The disclosure is objected to because of the following informalities:

The specification appears to contain minor typographical and other errors. For example, on page 5, in paragraphs 0011 and 0012, it appears that references to "identity certificate 204" are intended to refer instead to "identity certificate 202"; on page 6, line 4 of paragraph 0015, it appears that "cert6ificate" is intended to read "certificate"; and on page 9, paragraph 0023, there is a reference to "the client 622", although reference numeral 622 indicates a certificate in Figure 6.

Appropriate correction is required. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 9-17 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 9-14 are directed to a "machine-accessible medium" including a computer program for performing method steps. The term "machine-accessible medium" is broad enough to encompass, for example, a computer program written on paper. This is a computer program or data structure *per se*. Functional descriptive material such as a

computer program *per se* that is not embodied in a computer readable medium is not statutory subject matter. See MPEP § 2106 IV.B.1(a).

Claims 15-17 are directed to a data signal including a digital certificate and a URI. This is data *per se* and is not tangibly embodied in a computer readable medium. Further, the claim elements solely recite a mere arrangement of data, which constitutes non-functional descriptive material, and is not statutory subject matter. See MPEP § 2106 IV.B.1.

5. To expedite a complete examination of the instant application, the claims rejected under 35 U.S.C. 101 above are further rejected as set forth below in anticipation of applicant amending these claims to place them within the statutory classes of invention.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1-14 and 16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "the first certificate" in lines 9-10. However, the claim also recites "at least one first certificate" in line 2. If there is more than one first certificate, it is unclear to which certificate "the first certificate" of lines 9-10 refers. This

renders the claim indefinite. Similarly, Claims 5-8 each recite the limitation "the first certificate"; the claims are indefinite by a similar rationale. For purposes of interpreting the prior art, "the first certificate" is assumed to refer to the at least one first certificate.

Further in reference to Claim 1, the limitation "providing, by the client to the third party, at least one second certificate" renders the claim indefinite. It is unclear what the purpose or use of the second certificate is, as the second certificate is not referred to in Claim 1 or any of its dependent claims aside from the provision of the second certificate.

Further in reference to Claim 8, the limitation "revoking, by the client, the first certificate" renders the claim indefinite because it is unclear how the client can revoke the first certificate when the first certificate is provided by the authorizer.

Claim 9 recites the limitation "the at least one first certificate" in line 5. There is insufficient antecedent basis for this limitation in the claim. For purposes of interpreting the prior art, it is assumed that this is intended to refer to the first certificate of line 3. Further, the claim recites the limitation "the machine" in line 2; there is insufficient antecedent basis for this limitation in the claim.

Claim 12 recites the limitation "granting, by the authorizer, access to the third party". It is unclear whether "granting access to the third party" is to be read as the third party is allowed to access another party such as the authorizer, or as another party being allowed to access the third party. This renders the claim indefinite. For purposes of interpreting the prior art, the former interpretation is assumed.

Claim 16 recites the limitation "the second digital certificate grants less power than the first digital certificate". The phrase "grants less power" is generally vague and does not set forth a definite meaning for "less power".

Claims not specifically referred to above are rejected due to their dependence on a rejected base claim.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 1-9 and 12-16 are rejected under 35 U.S.C. 102(e) as being anticipated by McGarvey, US Patent 6643774.

In reference to Claim 1, McGarvey discloses a method including a client storing a first certificate from an authorizer, the client storing a URI associated with the first certificate and a third party, the client providing a certificate and the URI to the third party (see column 12, lines 22-26), and the client providing the first certificate to the authorizer upon the authorizer accessing the URI, in which the client retains control over the third party's use of the first certificate (see Figures 3 and 8, where the client 300

corresponds to the client of the present claim, the server 310 corresponds to the third party of the present claim, and private key system 330 corresponds to the authorizer of the present claim; see also column 11, line 37-column 12, line 11).

In reference to Claims 2 and 3, McGarvey further discloses providing a short-term use certificate to the third party (column 12, lines 30-35).

In reference to Claim 4, McGarvey further discloses authenticating the authorizer upon accessing the URI (column 11, lines 60-61).

In reference to Claims 5 and 6, McGarvey further discloses limiting and tracking the third party's use of the first certificate (column 8, lines 8-13).

In reference to Claim 7, McGarvey further discloses that the contents of the first certificate are not revealed to the third party (see column 11, lines 42-46).

In reference to Claim 8, McGarvey further discloses that the first certificate can be revoked (see column 12, lines 30-36).

In reference to Claim 9, McGarvey discloses a computer-implemented method including a client receiving a first certificate from an authorize, the client generating a URI associated with the first certificate and a third party, the client providing a second certificate and the URI to the third party (see column 12, lines 22-26), and the client providing the first certificate to the authorizer upon the authorizer accessing the URI after the third party has provided the second certificate and URI to the authorizer (see Figures 3 and 8, where the client 300 corresponds to the client of the present claim, the server 310 corresponds to the third party of the present claim, and private key system

330 corresponds to the authorizer of the present claim; see also column 11, line 37-column 12, line 11).

In reference to Claim 12, McGarvey further discloses that the third party is granted access to the authorizer (column 8, lines 4-19).

In reference to Claim 13, McGarvey further discloses tracking a use of the second certificate (column 8, lines 8-13).

In reference to Claim 14, McGarvey further discloses that the second certificate can be revoked (column 8, lines 10-13; column 12, lines 30-36).

In reference to Claims 15 and 16, McGarvey discloses a second digital certificate issued from a client to a third party (see Figures 3 and 8, where the client 300 corresponds to the client of the present claim, the server 310 corresponds to the third party of the present claim, and private key system 330 corresponds to the authorizer of the present claim; see also column 11, line 37-column 12, line 11) and a URI capable of retrieving a first digital certificate from a database associated with the client (see column 12, lines 22-26).

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over McGarvey in view of Eastlake et al, "XML-Signature Syntax and Processing".

McGarvey discloses everything as applied above to Claim 9. However, McGarvey does not explicitly disclose the use of XML signatures. Eastlake discloses that XML signatures can be used to apply digital signatures to the content of resources that may be external to the signature itself (page 4, section 1.0, "Introduction"). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of McGarvey to include the use of XML signatures, in order to provide integrity and message or signer authentication (see Eastlake, page 1, Abstract).

12. Claims 11 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over McGarvey in view of Ellison et al, "SPKI Certificate Theory".

In reference to Claim 11, McGarvey discloses everything as applied above to Claim 9. In reference to Claim 17, McGarvey discloses everything as applied above to Claim 15. However, McGarvey does not explicitly disclose the use of SPKI certificates. Ellison et al disclose that authorization certificates can be used to delegate authorizations (page 14, section 4, "Delegation") and that SPKI certificates can be used to define an authorization certificate (page 13, section 3.3, "SPKI Certificates"). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the systems of McGarvey to include the use of SPKI

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certificates, in order to allow for authorizations to be delegated without needing to involve the owner of the resource concerned (see Ellison, page 14, section 4).

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. Lipkin et al, US Patent 6138235, discloses a method for controlling access to services using a chain of certificates delegating authorization.
- b. Davis et al, US Patent 6367009, discloses a system for delegating authorization and authentication using certificates.
- c. Corella, US Patent 6763459, discloses a system using short term SPKI authorization certificates.
- d. Wray, UK Patent Application GB 2357225, discloses certificates for delegation using SPKI certificates.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Zachary A. Davis whose telephone number is (571) 272-3870. The examiner can normally be reached on weekdays 8:30-6:00, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Emmanuel Moise can be reached on (571) 272-3865. The fax phone

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number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ZAD
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Matthew B. Smithers
MATTHEW SMITHERS
PRIMARY EXAMINER
Art Unit 2137